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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,619	12/29/2000	Jesse Salb	04646.P003D	1327

7590

06/04/2003

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 06/04/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/752,619

Applicant(s)

SALB, JESSE

Examiner

D. L. Jones

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/15/02; 11/18/02; 2/20/03; and 3/13/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 65-70 and 76-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 65-70 and 76-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6,7,&9.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 8.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1616

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of Paper No. 10, filed 3/13/03, wherein claims 71-75 were canceled and claims 65 and 76 were amended.

Note: Claims 65-70 and 76-79 are pending.

2. The Examiner acknowledges receipt of the acceptable terminal disclaimers filed 3/13/02, Paper No. 11.

RESPONSE TO APPLICANT'S ARGUMENTS/AMENDMENTS

3. The Applicant's arguments filed 3/13/03 (Paper No. 10) to the rejection of claims 65-70 and 76-79 made by the Examiner under obviousness type double patenting have been fully considered and deemed persuasive for reasons of record. Thus, the double patenting rejections are WITHDRAWN.

NEW GROUNDS OF REJECTION

112 First Paragraph Rejections (New Matter)

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 65-70 and 76-79 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

Art Unit: 1616

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims (see independent claim 65) have been amended to read that “the X moiety is an aryl...and which may be further substituted’. However, the claim as amended is inconsistent with what is found in the specification and the originally filed claims. For example, page 28 of the specification reads “the X moiety is an unsubstituted or substituted C1-C8 alkyl...to approximately Z =74”. Thus, there is no disclosure that X is aryl and that there is further substitution on the variable X. While the originally filed claims (see claims 68, line3; claim 69, line 3; and claim 70, line 3) disclose a substituted aryl group, neither the specification nor the originally filed claims disclose an unsubstituted aryl. If Applicant is in disagreement with the Examiner’s position, Applicant is respectfully requested to point to page(s) and line number(s) wherein support for unsubstituted aryl groups is disclosed. Also, the specification, page 28, line 18, does not disclose any further substitution that occurs on the X moiety. One again, if Applicant is in disagreement with the Examiner, please point out support in the instant application.

Note: In the telephonic interview on 2/10/03, the incorporation of the term ‘substituted aryl’, not ‘aryl’ was discussed. The instant invention discloses substituted aryl groups only (e.g., claim 68, line 3; claim 69, line 3; and claim 70, line 3).

112 Second Paragraph Rejections

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1616

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 65 and 76-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 65, line 6: The claim as written is ambiguous because of the phrase 'which may be further substituted'. What substitutions are Applicant referring to (e.g., with alkyl, etc. groups)? Please clarify and point to support in the specification (e.g., page(s) and line number(s)) for such terminology.

Claims 76-79: The claims as written are ambiguous because the claims depend upon claim 65 which defines the variables S (pyranose), X, and L. However, in amended claim 76, the definitions of the variables S, X, and L are not necessarily those of independent claim 65. For example, while claim 65 reads "S moiety is a pyranose", claim 76 read 'S is a binding moiety which selectively binds to a cellular molecule in said tissue'. Applicant is respectfully requested to clarify the claim in order that one may readily ascertain what is being claimed.

COMMENTS/NOTES

8. It is respectfully suggested that Applicant replace the phrase 'capable of being attenuated' with 'attenuates' in claim 76, line 9. In particular, it is noted that the recitation that an element is 'capable of' performing a function is not a positive limitation, but only requires the ability to so perform that function. Hence, such phrase does not constitute a limitation in any patentable sense (In re Hutchison, 69 USPQ 138).

Art Unit: 1616

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (703) 308-4640. The examiner can normally be reached on Mon.-Fri. (alternate Mon.), 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose' Dees can be reached on (703) 308- 4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Art Unit: 1616

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read "D. L. Jones", with a stylized, cursive script.

D. L. Jones
Primary Examiner
Art Unit 1616

May 29, 2003